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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/437,414 | 11/10/1999 | ALEKSANDER SZLAM | 031041.0091 | 7944 |

23370 7590 01/25/2005

JOHN S. PRATT, ESQ
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ATLANTA, GA 30309

| EXAMINER | |
|---|---|
| HOOSAIN, ALLAN | |
| **ART UNIT** | **PAPER NUMBER** |
| 2645 | |

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/437,414 | SZLAM ET AL. | |
| | Examiner | Art Unit | |
| | Allan Hoosain | 2645 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *Amendment C, 6/24/04*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *93-101* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *93-101* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *6/24/04* .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Allowable Subject Matter*

1. Applicant is advised that the Notice of Allowance indicated to Applicants on 6/24/04 but not mailed is vacated for the reasons given in the Sections below. See also the attached PTOL-413. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 93-101 are rejected under the judicially created doctrine of double patenting over claims 1,8-13 of U. S. 5,214,688 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

US 5,214,688, recites limitations which are substantially the same and broader in scope as recited in the claims of the instant Application. For example, US 5,214,688, Claim 1, recites "generating statistics concerning said inbound calls and said outbound calls" and "adjusting the rate of placement of said outbound calls in response to said statistics on said inbound calls and said outbound calls". Claim 8 of the patent recites "adjusting the size of said first group (inbound) and said second group (outbound) in response to said degree of usage (inbound). The instant application, claim 93, recites "obtaining a statistic on said outbound calls" and "adjusting said processing of said inbound calls based upon said statistic". It is obvious that the limitations of patented claims 1 and 8 teaches the limitations of claim 93. Similarly, it is obvious that the limitations of Claims 93-101 are taught by Claims 1 and 8-13 of the patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application

which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 251***

4. The original declaration is defective:

(a) It would appear as though the declaration filed was a copy of the declaration for the original parent reissue Patent.

(i) SN is for the original reissue Patent application

(ii) The date of execution is four years prior to the filing of the current reissue application.

(b) Failure to specifically identify an error in the original Patent which renders the Patent either wholly or partly inoperative or invalid (see MPEP § 1414). The listed error references claims which are no longer in the application. Is the error for the original reissue? If so, then this error should have been corrected in the original reissue application. Therefore, what error is still present in the parent Patent which causes that Patent to still be either wholly or partly inoperative or invalid.

(c) All of the inventors are not listed on the declaration. It doesn't matter if the inventors sign different declarations. However, each declaration MUST list all inventors.

(d) It appears as though additional changes have been made since the last declaration, i.e., a declaration does not exist which contains the statement that all errors up until the filing of the current declaration, was without deceptive intent. In other words, every departure from the

original Patent is an "error". A declaration is needed to cover each and every "error" with the "Without deceptive intent" clause.

(e) A new declaration is required which satisfies 37 CFR § 1.63 and § 1.175.

(f) In addition, the following comments must be addressed:

1f. The issue of recapture has not been addressed given that the parent Patent application and intermediate reissue application were not provided with the reissue application. The Parent application is apparently lost. Applicants are asked to submit copies of original claims and then any amendments and arguments made during prosecution of the Parent application.

2f. This application is a continuation reissue application. The first paragraph of the parent reissue Patent needs to be amended via Certificate of Correction and the current reissue application needs to be amended to reference the other parent reissue application, see MPEP § 1451.

3f. Amendments to Claims must comply with 37 CFR 1.173(b), i.e., underlining and bracketing of the claims. Amendments A and B submitted on 7/11/00 and 10/1/02 respectively do not comply and must be resubmitted. In addition, Examiner's Amendments would also not comply.

4f. Regarding the surrender of the original Patent, it is assumed that it was surrendered in the parent Reissue. However, there is no statement to that effect. The statement is needed or the surrender of the Patent or a statement as to the loss or inaccessibility.

5f. The Assent and 3.73(b) are defective. The date of execution appears to be at least 2 years prior to the filing of the present reissue which leads one to believe that these are copies of

the Assent and 3.73(b) for the parent reissue Patent. Meanwhile, Office records reflect that there is a new Assignee. Therefore, the new Assignee needs to submit a new Assent and 3.73(b) statement.

6f. A PTO 1449 listing all of the references considered in the parent Patent application must be submitted.

5. Claims 93-101 are rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the application is set forth in the discussion above in this Office action.

*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

None

7. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)

**Or:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Allan Hoosain

**Allan Hoosain**
**Primary Examiner**
**1/14/05**